

REMARKS

In response to the Office Action mailed on December 13, 2007 (hereinafter the "Office Action"), the Applicants respectfully request reconsideration in view of the following remarks.

Claims 1-7, 9, 11-16 and 18-22 are pending in the application. In the Office Action:

1. The specification is objected to under 35 U.S.C. § 132(a) as allegedly introducing new matter;
2. Claims 1, 13, and 19 are rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement; and
3. Claims 1-7, 9, 11-16 and 18-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagendran (U.S. Patent No. 6,731,940, hereinafter "Nagendran") in view of Brody et al. (U.S. Patent No. 4,670,899, hereinafter "Brody") and further in view of Larsson et al. (U.S. Patent No. 6,643,307, hereinafter "Larsson").

Objection to the Specification - 35 U.S.C. § 132(a)

In the Office Action, the specification is objected under 35 U.S.C. § 132(a) as allegedly introducing new matter. Specifically, the Office Action states:

The added material, which is not supported by the original disclosure is as follows: identification information by extracting the location of the entry node from the resource identification information without querying a database in communication with the entry node, the database storing location information. However, the Examiner is confused because at the same time, the Specification, with reference to page 9, lines 23-25, teaches that the location information is determined by a look up query of the entry node's database.

See Office Action, page 2, lines 12-18. Applicants respectfully traverse this objection.

In response, Applicants respectfully submit the specification states:

Alternatively, the location of an entry node may be included in the resource identification information provided by the entry node. Accordingly, once the resource identification information is received by the host 40, the host 40 will have the location of the entry node 53 without querying the entry node database.

See Specification, page 9, lines 25-29. As a result, the specification clearly discloses extracting an entry node location from the resource identification information without querying a database.

In addition, objections to the specification under 35 U.S.C. § 132 are only appropriate if “new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings.” See MPEP 2163.06(I). Furthermore, “[i]f new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement.” Id. (citing In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).) Accordingly, Applicants respectfully request this objection be withdrawn.

Claim Rejections - 35 U.S.C. §112, First Paragraph

Claims 1, 13, and 19 are rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Specifically, the Office Action states:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material, which is not supported by the original disclosure is as follows: identification information by extracting the location of the entry node from the resource identification information without querying a database in communication with the entry node, the database storing location information. However, the Examiner is confused because at the same time, the Specification, with reference to page 9, lines 23-25, teaches that the location information is determined by a look up query of the entry node's database.

See Office Action, page 3, lines 8-17. The rejection of these claims is respectfully traversed.

As stated above, the specification clearly discloses extracting an entry node location from the resource identification information without querying a database. See Specification, page 9, lines 25-29. Therefore, Applicants have specifically pointed out support for the amendments made to the claims in the Amendment filed October 31, 2007 (hereinafter the “October 31 Amendment”). See MPEP 2163.06(I). Accordingly, Applicants respectfully request this rejection be withdrawn.

Claim Rejections - 35 U.S.C. §103

Claims 1-7, 9, 11-16 and 18-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagendran in view of Brody and further in view of Larsson. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Office Action fails to address the recitations added by the October 31 Amendment. For example, the current rejection of claim 1 fails to address the recitation “wherein determining the location of the entry node based on the resource identification information from the entry node includes extracting the location of the entry node from the resource identification information without querying a database in communication with the entry node, the database storing location information.”

The MPEP states that examiners should consider alleged new matter added to claims make rejections based on prior art since a new matter rejection under 35 U.S.C. § 112, first paragraph may be overcome by applicant. See MPEP 2163.06(I). The October 31 Amendment was in response to a Final Office Action dated July 18, 2007 (hereinafter the “Final Office Action”). Evidence that the Office Action does not address the aforementioned recitation is that the rejections of claims 1, 13, and 19 in the Office Action are verbatim copies of the rejections of claims 1, 13, and 19 in the Final Office Action. Compare, e.g., Final Office Action page 2, line 13-page 4, line 7. and Office Action, page 4-page 5, line 22. As a result, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request this rejection be withdrawn.

Based on the foregoing and the remarks filed with the October 31 Amendment, the combination of Nagendran, Brody, and Larsson fails to teach or disclose each and every feature specified in claim 1. Therefore, claim 1 is allowable and the rejection of this claim should be

withdrawn. Claims 2-7 and 9 depend from claim 1, and are thus allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn. Claims 13 and 19 specify similar features as claim 1 and thus are allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn. Claims 14-16, 18, and 20-22 depend from claims 13 and 19, and are thus allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,
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